

REMARKS

The last Office Action has been carefully considered.

It is noted that claims 1-5 are rejected under 35 U.S.C. 103(a) over the patent to Meroni in view of the patent to Pitts.

Claims 6-8 are rejected under 35 U.S.C. 103(a) over the patents to Meroni in view of the patents to Pitts and Dong.

After carefully considering the Examiner's grounds for the rejection of the claims over the art, applicants have canceled claims 1-8 and submitted two new claims, including claim 9 which is an independent claim, and claim 10 which depends on it.

It is respectfully submitted that the new features of the present invention which are now defined in the submitted claims are not disclosed in the references.

Before the analysis of the prior art, it is believed to be advisable to explain to the Examiner the subject matter of the present invention in detail.

Claim 1 defines a floor covering base based on a perforated polyvinyl chloride sheet. The floor covering has an integrated sheet body prepared by laminating and fusing 2-20 perforated high density polyvinyl chloride sheets, each having a plurality of holes. A glass fiber sheet is attached to an upper or a lower side of the integrated sheet body. A wood thin film having a UV coated layer is attached to the uppermost side of the resulting integrated sheet body.

Turning now to the references applied by the Examiner against the original claims, it is respectfully submitted that the patent to Meroni discloses a single layer polyvinyl chloride base. However, it does not teach a perforated high density sheet consisting of 2-20 high density sheets joined together with heat, together with other features of the present invention as defined in claim 8.

The patents to Pitts teaches two layers of polyvinyl chloride with perforations aligned with one another. However, it does not teach the other features of the present invention which are now defined in claim 9.

The Examiner rejected the original claims over the combination of these two references. It is respectfully submitted that none of the references teaches the new features of the present invention which are now defined in claim 9. In order to arrive at the applicant's invention the teaching of each reference has to be fundamentally modified by including into it the features which were first proposed by the applicant of the present invention as defined in claim 9. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision *in re Randol and Redford* (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Definitely, the references do not contain any hint or suggestion for such modifications.

It is therefore believed to be clear that the Examiner's rejection of original claims 1-5 over the combination of these two references should be considered as no longer tenable with respect to claim 9 and should be withdrawn.

Since the Examiner rejected some dependent claims over the combination of the patents to Meroni, Pitts and Dong.

As for this rejection it is respectfully submitted that while Meroni, Dong and Pitts teach some features of the present invention, none of the references teaches all features of the present invention as now defined in claim 9. It is respectfully submitted that it is believed that it is not obvious to combine the references. In the decision ACS Hosp. Sys., Inc. v. Montefiore Hosp., 221 USPQ 929, 932, 933 (Fed Cir. 1984) it was stated:

"Obviousness can not be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. The prior art of record fails to provide any such suggestion or incentive."

Definitely, the references do not contain any hint or suggestion for the combination of the three references proposed by the Examiner.

As for this combination of the references, it is again respectfully submitted that in order to arrive at the applicant's invention from the reference, the reference has to be fundamentally modified, which as exemplified by the decision presented herein above, can not be considered as obvious, since the references do not contain any hint or suggestion for such modifications.

In view of the above presented remarks and amendments, it is believed that claim 9, the broadest claim on file, should be considered as patentably distinguishing over the art and should be allowed.

As for claim 10, this claim contains additional features which in combination of the features of claim 9 are also not disclosed in the references and can not be derived from them as a matter of obviousness.

It is therefore respectfully submitted to allow claim 10 as well.

It is noted that the name of the inventor has been indicated in the Office Action as Woo Je-Suk.

However, the correct name of the inventor is Je-Suk Woo. A signed statement of the inventor is attached hereto. Correction is respectfully requested.

Additionally, it has been noted that the name of the inventor Hyeong-Keor Yoo has been incorrectly indicated. The correct name of this inventor is Hyeong-Keor Yoo and a signed statement of this inventor is also attached hereto. Correction is respectfully requested.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be

helpful in advancing this case to allowance, he is invited to telephone the  
undersigned (at 631-549-4700).

Respectfully submitted,

  
Michael J. Striker  
Attorney for Applicants  
Reg. No. 27233

I, Hyeong-Keor Yoo, hereby state that my first name is Hyeong-Keor and my surname is Yoo.

I am one of the inventors named in U.S. Patent Application Serial No. 10/080,456 and I request that my name therein be corrected.

I hereby declare that all statements made herein of my own knowledge are true and that all statements on information and belief are believed to be true; and further that those statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Dated: 17th day of September 2002

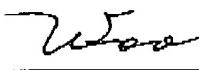
  
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HYEONG-KEOR YOO

I, Je-Suk Woo, hereby state that my first name is Je-Suk and my surname is Woo.

I am one of the inventors named in U.S. Patent Application Serial No. 10/080,456 and I request that my name therein be corrected.

I hereby declare that all statements made herein of my own knowledge are true and that all statements on information and belief are believed to be true; and further that those statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Dated: 17th day of September 2002

  
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JE-SUK WOO